

REMARKS

At the time of the Office Action dated November 18, 2003, claims 1-19 were pending and rejected in this application. Claims 1, 5, 7-9, 12, 14 and 18-19 have been amended to clarify the limitations recited therein. Claims 15-17 have been cancelled, and new claims 20-22 have been added. Applicants submit that the present Amendment does not generate any new matter issue.

In the second enumerated paragraph of the Office Action, the Examiner objected to the specification, asserting that the specification includes "embedded hyperlink and/or other form of browser-executable code." This rejection is respectfully traversed.

The terms referred to by the Examiner are necessary parts of the disclosure. As discussed in M.P.E.P § 608.01, "[w]here the hyperlinks and/or other forms of browser-executable code are part of applicant's invention ... and applicant does not intend to have these hyperlinks be active links, examiner should not object these hyperlinks." Applicants' intention is not intended to have these hyperlinks active, and therefore, Applicants respectfully solicit withdrawal of the application.

CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 101

In the second enumerated paragraph of the Office Action, the Examiner asserted that "[n]o form of technology is claimed." This rejection is respectfully traversed.

35 U.S.C. § 101, states the following:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements therefore, may obtain a patent therefor, subject to the conditions and requirements of this title.

Upon reviewing this section upon which the present rejections is based, Applicants are unable to find the requirement that the claimed invention be a "form of technology" or fall within "the technological arts." Applicants, in claims 1-17, have claimed a method (i.e., a process), and "any new and useful process" (emphasis added) is specifically identified in 35 U.S.C. § 101 as being patentable. Furthermore, the most recent case out of the Federal Circuit that extensively explored the requirements 35 U.S.C. § 101, is State Street Bank & Trust Co. v. Signature Financial Group, Inc.,¹ and upon reviewing this decision, Applicants are also unable to determine where the "technology" requirement is articulated. As such, Applicants question the Examiner's requirement that the claimed invention be a form of technology.

Even *assuming arguendo* that some requirement exists for claims to be directed to a form of technology or be within the technological arts, Applicants question the Examiner's definition of the term terminology. It is unquestioned that a translation formula is a form of technology. Web addresses or domain names are also unquestionably a form of technology. If the Examiner continues to disagree that these features are not related to "technology," Applicants request the Examiner provide a clear and court-recognized definition as to what constitutes technology. Based upon the plain language of 35 U.S.C. § 101, pending claims 1-14 are directed to statutory

¹ 149 F.3d 1368, 47 USPQ2d 1596 (Fed Cir. 1998)

subject matter, and Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-14 under 35 U.S.C. § 101.

CLAIMS 1-17 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

In the third enumerated paragraph of the Office Action, the Examiner asserted that "the essential step of translating Web request is omitted from the claims." This rejection is respectfully traversed.

Independent claims 1, 12, 18 and 19 have been amended, and the phrase "translating Web requests," has been removed in each of these claims. Since this was the phrase to which the Examiner specifically referred, Applicants respectfully submit that the deletion of this phrase has overcome the Examiner's rejections. Applicants, therefore, solicit withdrawal of the imposed rejections of claims 1-14 under the second paragraph of 35 U.S.C. § 112

CLAIMS 1, 14-15 AND 19 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

In the fourth enumerated paragraph of the Office Action, the Examiner objected to phrases in each of claims 1, 14-15 and 19. This rejection is respectfully traversed.

Claims 1, 14 and 19 have been amended. Specifically, claims 1 and 19 have been amended to delete the phrase to which the Examiner referred. Claim 14 has been amended to provide antecedent basis for the term "said second translation formula." Applicants, therefore,

respectfully solicit withdrawal of the imposed rejections of claims 1, 14 and 19 under the second paragraph of 35 U.S.C. § 112

**CLAIMS 1, 2-7, 9-10, 12-13 AND 16-19 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY OSAKU ET AL., U.S. PATENT NO. 6,061,738 (HEREINAFTER OSAKU)**

In the fifth enumerated paragraph of the Office Action, the Examiner asserted that Osaku identically discloses the claimed invention. This rejection is respectfully traversed.

On page five of the Office Action, the Examiner referred to column 13, line 27 and column 14, lines 14-15 of Osaku as identically disclosing the claimed translation formula. Applicants respectfully disagree. Osaku does not advocate using a translation formula as that term is termed is used within the claims. The claimed translation formula modifies the received name using a formula. Osaku, however, does not involve using a formula. Instead, as illustrated in Fig. 23, Osaku takes a identifier, such as a shortened number, and searches for the number in a registration table (i.e., feature 420). The URL that is output for the identifier need not be at all related to the identifier. In contrast, the claimed invention takes the received name and manipulates that name with a formula. Since this operation is not disclosed by Osaku, Osaku fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

New claims 20-22 further distinguish the claimed invention over Osaku. These claims each recite that the scheme-specific name is only a top-level domain name. All of the URLs output by Osaku include server-side instructions, and thus, Osaku fails to teach that the scheme-specific name is only a top-level domain.

**CLAIMS 1-2, 4-7, 16 AND 18-19 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY BUCHHOLZ ET AL., U.S. PATENT NO. 5,956,490 (HEREINAFTER BUCHHOLZ)**

In the sixth enumerated paragraph of the Office Action, the Examiner asserted that Buchholz identically discloses the claimed invention. This rejection is respectfully traversed.

Independent claims 1, 18 and 19 each recite that a name is received on the computer that is associated with a domain name and that a request is generated on the computer for the domain name based upon a scheme-specific name. Neither the client nor the server of Buchholz individually both receive a name associated with a domain name and generate a request for the domain name based upon a scheme-specific name. The client of Buchholz does not generate a scheme-specific name. Instead, the client of Buchholz produces a compressed URI, which is not comparable to the claimed scheme-specific name. The server of Buchholz does not receive a name associated with a domain name. Instead, the server of Buchholz receives a compressed URI, which is not comparable to the claimed name associated with a domain name. Therefore, Buchholz fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

**CLAIMS 11 AND 15 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OSAKU IN VIEW OF WANG ET AL., U.S. PUBLICATION NO. 2002/0042736 (HEREINAFTER
WANG)**

Claim 11 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §

102 for anticipation based upon Osaku. The secondary references to Wang does not cure the argued deficiencies of Osaku. Accordingly, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 11 under 35 U.S.C. § 103 for obviousness based upon Osaku in view of Wang is not viable and, hence, solicit withdrawal thereof.

CLAIM 8 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON

BUCHHOLZ

Claim 8 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Buchholz. Applicants, therefore, respectfully submit that the imposed rejection of claim 8 under 35 U.S.C. § 103 for obviousness based upon Buchholz is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

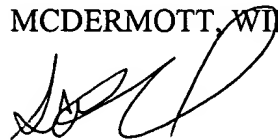
To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'SDP', is written over the firm name.

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